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In re Application of :
Daum et al. : DECISION DISMISSING PETITION
Application No. 10/078,622 : UNDER 37 CFR 1.78(a)(3)
Filed: February 19, 2002 :
Attorney Docket No. 126381.00901 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 17, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application, No. 10/044,475, filed January 10, 2002.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

The petition fails to comply with item (1) above.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications.

Initially, the Office notes that applicants did not indicate the relationship between the instant application and prior-filed nonprovisional application, No. 10/044,475, in the amendment filed concurrently with the instant petition. Accordingly, applicants failed to comply with the requirements of 37 CFR 1.78(a)(2)(iii). Before the petition under 37 CFR 1.78(a)(3) can be granted, applicants must file a renewed petition under 37 CFR 1.78(a)(3) and an amendment¹ or an Application Data Sheet, containing a reference to application, No. 10/044,475, and indicating its relationship to the instant application.

The Office further notes that applicants indicated in the first line of the specification submitted on filing that the instant application claimed priority to provisional application, No. 60/273,850, filed March 7, 2001. However, it is unclear whether applicants intended for the instant application to still claim priority to the prior-filed provisional application. The amendment filed concurrently with the instant petition does not contain a reference to provisional application, No. 60/273,850, and does not indicate that the instant application claims priority under 35 U.S.C. § 119(e) to the prior-filed provisional application. If applicants desire to claim priority to provisional application, No. 60/273,850, applicants must file a new amendment in compliance with 37 CFR 1.121 or an Application Data Sheet, referencing provisional application, No. 60/273,850, and nonprovisional application, No. 10/044,475, and indicating the relationship of the applications.

Further correspondence with respect to this matter should be addressed as follows:

¹ Note 37 CFR 1.121 and 37 CFR 1.4(c).

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Any questions concerning this matter may be directed to Petitions
Attorney Christina Tartera Donnell at (571) 272-3211.

A handwritten signature in cursive script that reads "Frances Hicks".

Frances Hicks
Lead Paralegal
Office of Petitions
Office of the Deputy Commission
for Patent Examination Policy